

§103(a) as allegedly being unpatentable over Scannell in view of Rochkind and further in view of Epstein et al. (U.S. Patent No. 6,327,343; hereinafter referred to as "Epstein"). Claim 103 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Scannell in view of Larson. Claims 105, 112 and 118 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Scannell in view of Epstein. Applicants contend that the cited art, either singly or in combination, teach or suggest the claimed subject matter of claims 98-118.

#### **Rejections Based Upon Judicially Created Doctrine of Obviousness-type Double Patenting**

Applicants request that the rejections based upon the judicially created doctrine of obviousness-type double patenting be held in abeyance until such time it is determined that claims are allowable.

#### **Rejections Based Upon 35 U.S.C. §102(b)**

With respect to independent claims 98, 106 and 113, Applicants respectfully request consideration of the following remarks. In the *Response to Arguments* of the current Office Action, the Examiner contends, "[I]t is noted that the features upon which applicant relies (i.e., prioritizes messages after filing the messages into multiple mailboxes) are not recited in the rejected claims (¶1, p. 12). Applicants disagree. Claim 98 states "depositing the message into at least two of a plurality of virtual mailboxes **wherein the message is prioritized within such virtual mailbox based upon the code [corresponding to the personalized identifier].**" This claim clearly states that the message is **within** the mailbox when prioritized. Further, unlike Scannell, Applicants' prioritization is based upon a "code corresponding to a personalized identifier" rather than a priority code.

Applicants believe there is some confusion about the difference between "prioritizing" a message and "sorting" a message based upon a priority code. Prioritization includes both the assignment of a priority code and the sorting, both of which occur in the claimed subject matter within multiple mailboxes. In contrast, Scannell is directed to sorting a message within a mailbox after assigning a priority code and prior to insertion into any mailbox. In other words, Scannell is only sorting, not prioritizing, within the mailbox.

Using the example provided in Office Action at ¶2, p.13, a scenario that would approximate Applicants' claimed subject matter would involve having a message that is prioritized with a high priority in one mailbox and with a low priority in another. Clearly, Scannell does not teach or suggest a system that provides this functionality.

In addition, claims 99, 107, 108 and 114 are allowable as being dependent upon allowable base claims and Applicants also respectfully request allowance of these claims as well.

In order to reject a claimed invention under §102(b), the cited reference must teach every aspect of the claimed invention either explicitly or impliedly. (M.P.E.P. §706.02). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, "All words in a claim must be considered in judging the patentability of that claim against prior art." (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970)).

#### **Rejections Based Upon 35 U.S.C. §103(a)**

In addition, claims 100-105, 108-112 and 115-118 are allowable as being dependent upon allowable base claims and Applicants also respectfully request allowance of these claims as well.

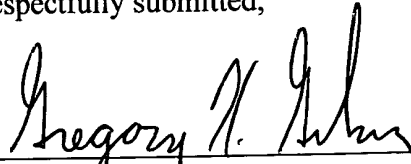
#### **CONCLUSION**

It is respectfully submitted that all issues and rejections have been adequately addressed and that pending claims 98-118 are allowable and that the case should be advanced to issuance. Although no fees are believed due with respect to thin amendment, if there are additional fees associated with this filing, the Commissioner is hereby authorized to charge or credit any overpayment to the deposit account of Fortkort Grether + Kelton, LLP, Deposit Account No. 50-2726.

If the Examiner has any questions or wishes to discuss the claims, the Examiner is encouraged to call the undersigned at the telephone number indicated below.

Via Express Mail Label EV 734547355 US  
Date of Mailing: August 11, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gregory K. Goshorn", written over a horizontal line.

Date: August 11, 2005

By: Gregory K. Goshorn

Reg. No.: 44,721

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